

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

R.

STEVEN KLEIMAN et al.

Serial No.: N/Y/A (CIP of App. Nos.
09/127,497 & 09/153,094)

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Art Unit: N/Y/A (parents: 2171 & 2177)

Examiner: N/Y/A (parents: UYEN LE &
LUKE WASSUM)

Honorable Assistant Commissioner
for Patents
Washington, D.C. 20231

PRELIMINARY FILING

Dear Sir:

This is a preliminary filing for a continuation-in-part of application no.

09/127,497, filed July 31, 1998 and also of application no. 09/153,094, filed Sept. 14, 1998 (now
allowed).

09/127,497 & 09/153,094

REMARKS:

This paper is being filed with the above-identified CIP application so as to explain the procedural status of the application for the Examiner's benefit and for the record.

Subject Matter of CIP Application

The disclosure of this CIP application is substantially identical to that of parent application no. 09/127,497. Applicants note that this parent application incorporated the disclosure of a parent of parent application no. 09/153,094 by reference. Thus, all matter disclosed in this CIP application is believed to have been disclosed by parent application no. 09/127,497, either directly or by incorporation of a parent of application no. 09/153,094.

The CIP application has been modified to correct formal matters raised in the prosecution of parent application no. 09/127,497, to recite claims rejected in the parent applications, to conform those claims to amendments made in the parents, and to renumber the claims. For the Examiner's reference, the following table shows the correlation between claims of this CIP application and claims in the parent applications.

<u>Claim in CIP Application</u>	<u>Claim in Parent Application</u>
1	1 from app. no. 09/127,497
2	2 from app. no. 09/127,497
3	3 from app. no. 09/127,497
4	4 from app. no. 09/127,497
5	5 from app. no. 09/127,497
6	6 from app. no. 09/127,497
7	7 from app. no. 09/127,497

Claim in CIP ApplicationClaim in Parent Application

8	8 from app. no. 09/127,497
9	9 from app. no. 09/127,497
10	13 from app. no. 09/127,497
11	15 from app. no. 09/127,497
12	16 from app. no. 09/127,497
13	17 from app. no. 09/127,497
14	18 from app. no. 09/127,497
15	19 from app. no. 09/127,497
16	23 from app. no. 09/127,497
17	24 from app. no. 09/127,497
18	25 from app. no. 09/127,497
19	26 from app. no. 09/127,497
20	27 from app. no. 09/127,497
21	28 from app. no. 09/127,497
22	34 from app. no. 09/127,497
23	35 from app. no. 09/127,497
24	36 from app. no. 09/127,497
25	43 from app. no. 09/127,497
26	51 from app. no. 09/127,497
27	58 from app. no. 09/127,497
28	59 from app. no. 09/127,497
29	60 from app. no. 09/127,497
30	61 from app. no. 09/127,497
31	62 from app. no. 09/127,497
32	63 from app. no. 09/127,497
33	67 from app. no. 09/127,497
34	68 from app. no. 09/127,497
35	70 from app. no. 09/127,497
36	72 from app. no. 09/127,497
37	73 from app. no. 09/127,497
38	74 from app. no. 09/127,497
39	75 from app. no. 09/127,497
40	76 from app. no. 09/127,497
41	78 from app. no. 09/127,497
42	79 from app. no. 09/127,497
43	80 from app. no. 09/127,497
44	81 from app. no. 09/127,497
45	83 from app. no. 09/127,497

<u>Claim in CIP Application</u>	<u>Claim in Parent Application</u>
46	84 from app. no. 09/127,497
47	85 from app. no. 09/127,497
48	86 from app. no. 09/127,497
49	88 from app. no. 09/127,497
50	91 from app. no. 09/127,497
51	93 from app. no. 09/127,497
52	3 from app. no. 09/153,094
53	3 from app. no. 09/153,094 (modified to remove “means” terminology)

Rejection of Claims from Parent application no. 09/127,497

Claims 1 to 51 correspond to claims rejected in parent application no. 09/127,497 under 35 U.S.C. § 102(e) or § 103(a) over U.S. Patent No. 5,819,292 (Hitz). Hitz is a parent of a parent of this CIP application, namely application no. 09/153,094. This CIP application therefore claims the same priority as is claimed by Hitz for any and all claims that recite subject matter disclosed by Hitz. Accordingly, a rejection over Hitz is not permissible.

Rejection of Claims from Parent application no. 09/153,094

Claim 52 corresponds to claim 3 rejected in parent application no. 09/153,094 under the judicially created doctrine of obviousness-type double patenting over claim 1 of U.S. Patent No. 5,819,292 (Hitz). Claim 53 is a version of claim 52 rewritten so as to remove “means for” terminology. Applicants intend to file a terminal disclaimer if and when a double patenting rejection over Hitz is the only outstanding issue in this case.

Inventorship

In an earlier response filed in parent application no. 09/127,497, Applicants declined to concede that the rejection of claims in that application over Hitz was proper. Applicants maintain that at least some of the claims in this CIP application that correspond to rejected claims in parent application no. 09/127,497 are not disclosed or suggested by Hitz. For example, Hitz does not use the term "shadow snapshot," which is recited by some of these claims. Accordingly, the inventors for this CIP application also include the inventors for parent application no. 09/127,497.

However, upon further consideration, Applicants concede that at least claim 34 from application no. 09/127,497, which is now claim 22, was fully disclosed by Hitz. Accordingly, this claim finds priority in the parent of Hitz, namely application no. 08/071,643, and the inventors for this CIP application include the inventors for this parent application. Furthermore, the inventors for Hitz are included because claims 52 and 53 are taken from a continuation of Hitz.

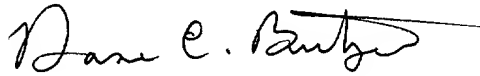
In view of the foregoing, inventorship for this CIP application is believed to be correct.

Closing

The entire application is believed to be in condition for allowance. Early passage to issue is respectfully requested at the Examiner's earliest convenience.

Applicants' undersigned attorney can be reached at (614) 486-3585. All correspondence should continue to be directed to the address indicated below.

Respectfully submitted,



Dated: April 30, 2001

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